

REMARKS

Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,226,618 (Downs). The Examiner is respectfully requested to withdraw the rejection of these claims in view of the following comments distinguishing them over Downs.

Over a period of approximately three and a half years, the Examiner has

1. Issued a first office action rejecting all claims in view of Wyatt and/or Mueller,
2. Issued a second office action continuing to reject all claims in view of Wyatt and/or Mueller,
3. Withdrawn all previous rejections in view of Wyatt and/or Mueller and issued a third office action rejecting all claims in view of Rhoads, after the Applicant filed an appeal brief,
4. Withdrawn all rejections in view of Rhoads alone and issued a fourth office action rejecting all claims in view of Rhoads and Ginter,
5. Issued a fifth office action continuing to reject in view of Rhoads and Ginter declaring the applicant's arguments against the previous rejection under the same grounds "moot", and
6. Withdrawn all rejections under Rhoads and Ginter and issued a sixth office action rejecting all claims in view of Downs.

In the most recent (sixth) office action, the Examiner's comments in support of the rejections of dependant claims 2-11, 13-22, 24-26 in view of Downs are substantially identical to the comments provided in the previous two office actions in which these claims were rejected in view of a combination of U.S. patents to Rhoads and Ginter, with the only significant difference being the global replacement of the name "Downs" for each occurrence of the name "Rhoads". In the Examiner's discussion of each dependant claim 2-11, 13-22, 24-26 the Examiner's column and line number citations remain unchanged such that, for example, where in the fifth office action the Examiner asserted that col. 17, lines 5-20 of Rhoads teaches the subject matter of claim 2, the Examiner, in the sixth office action, now asserts that col. 17,

lines 5-20 of Downs teaches the subject matter of claim 2. While this might be a matter of remarkable coincidence in the organization of the Downs and Rhoads patents, a review of col. 17 of Downs reveals that it clearly has nothing to do with the subject matter of claim 2 and that many of the cited lines of col. 17 of Downs do not exist. The Examiner's citations of Downs with respect to the other claims 2-11, 13-22, 24-26 are similarly erroneous, thereby raising a question as to whether the Examiner has fully considered whether Downs teaches the additional limitations recited in the applicant's dependant claims. Since the Examiner's citations of Downs with respect to claims 2-11, 13-22 and 24-26 are clearly in error, it would be of no benefit for the applicant to directly respond to the Examiner's arguments based on those erroneous citations. Nonetheless, since the Examiner at paragraph 14 of the sixth office action has respectfully requested the applicant in preparing a response, to fully consider the references as potentially teaching all or part of the claimed invention, the applicant has honored that request in preparing the remarks below.

During the three and one half years since receiving the first office action, the applicant has made substantive amendments to the claims that might have necessitated a new search only in response to that first office action, and the Examiner continued to reject under the same grounds in the second office action. The Examiner has since performed new searches three times, none of which were necessitated by claim amendments and none of which resulted in citing a reference that was not available at the time of the first search. The Examiner's attention is respectfully directed to MPEP 904 which states:

"The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first reply, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. The first search should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants."

The additional three searches have resulted in an unnecessarily protracted examination that has been a financial hardship on the applicant and that has unduly delayed issuance of a patent to which the applicant appears to be entitled. If the Examiner is of the opinion that the prior art has not yet been adequately searched relative to the applicant's claims, then in the interests of bringing prosecution of this application to a timely conclusion, the applicant respectfully requests that the Examiner

1. fully search the prior art prior to issuing a seventh office action,
2. carefully consider each claim in view of the prior art,
3. accurately direct the applicant's attention to specific sections of any cited prior art the Examiner believes teach or suggest each element of each rejected claim, and clearly explain the relevance of each such section to the applicant's claims,
4. fully consider any arguments the applicant may subsequently give against any claim rejection,
5. provide a clear explanation as to why the Examiner may consider any of the applicant's arguments to be unpersuasive, and
6. allow any claims the Examiner finds allowable over previously cited prior art without performing yet another prior art search, except per MPEP 904 to determine whether relevant documents have become available since the last search.

Claims 1-26

The Examiner cites a single reference (Downs) against claims 1-26 and argues that Downs teaches every element of every claim. It is therefore unclear as to why the Examiner rejected all claims under 35 U.S.C. 103 as being obvious in view of Downs rather than under 35 U.S.C. 102 as being anticipated by Downs. If the Examiner is aware of a failure on the part of Downs to specifically teach any element of any claim that necessitated the rejection under 35 U.S.C. 103 rather than under 35 U.S.C. 102, the Examiner is respectfully requested to point out the element that the Examiner believes Downs fails to teach.

Claim 1

The applicant's invention as recited in claim 1, and the document delivery system taught by Downs, are both concerned with sending files from a source computer to a destination ("end-user") computer. Claim 1 and Downs are also both concerned with licensing, however while claim 1 is concerned with licenses associated with software running on the source computer that forwards a document to a destination computer, Downs is concerned with licenses associated with the end-user that receives and wishes to access a document. As discussed below, the difference between the two licensing concerns renders claim 1 patentably distinct.

Relevant sections of Downs (col. 6, line 66 through col. 7 line 18) are reprinted below for convenience:

"Rights management in the Secure Digital Content Electronic Distribution System is implemented through a set of functions distributed among the operating components of the system. Its primary functions include:

licensing authorization and control so that content is unlocked only by authorized intermediate or End-User(s) that have secured a license; and

control and enforcement of content usage according to the conditions of purchase or license, such as permitted number of copies, number of plays, and the time interval or term the license may be valid"

"The Clearinghouse(s) provides licensing authorization by enabling intermediate or End-User(s) to unlock content after verification of a successful completion of a licensing transaction. "

"Secure Containers are used to distribute encrypted content and information among the system components."

This indicates that Downs is concerned with licensing end-users who want to access content that is locked within encoded "secured containers" for purposes of viewing or making copies of that content.

Nothing anywhere in Downs indicates that a secure container or the document it might convey includes an embedded "license stamp"

indicating that the container or the document it conveys was forwarded by licensed server software as recited in claim 1.

Downs is concerned with preventing an unlicensed end-user from accessing a file unless the end-user first obtains a license to do so.

Downs' system is useful, for example, when a music distributor wants to distribute music files to end users, and wants them to pay a royalty for listening to it. Downs teaches to embed a file in an encrypted secured container and only provide an end-user with a decryption key enabling the user to access the file if the end-user first obtains a license to do so.

The applicant's invention as recited in claim 1, on the other hand, seeks to prevent particular software on the end-user's computer from making use of a data file unless the data file is from licensed server software. Accordingly, claim 1 recites "including within the server software ... means for embedding a license stamp into each data file ... wherein the license stamp indicates that the data file was forwarded by licensed server software." Claim 1 also recites "adapting the processing software (in the destination computer) ... so that it processes each data file ... only when [it] contains the embedded license stamp."

Note that the license stamp indicates that the server software on the source computer is licensed and that the processing software won't process the data file unless the source of the file was licensed - it makes no difference to the applicant's invention as to whether the end-user has or has not obtained a license to access the data file.

The applicant's invention of claim 1 is useful, for example, where a company sells licensed software (such Adobe's Acrobat creator software) that creates data files (such as pdf file) but has distributed free viewer software (such as Acrobat's free pdf reader software) that can read but not create data files. By distributing its free Acrobat reader software, Adobe makes its Acrobat creator software more valuable to customers who buy it because they know that anyone who receives a pdf they produce will be able to view the pdf files they create.

If Adobe's pdf format were not proprietary, other companies could make and sell software not licensed by Adobe that could create pdf files, and any of the Acrobat readers Adobe has taken the trouble to

distribute could also read pdf files created by the competitor's pdf creator software. Thus Adobe's installed base of Acrobat viewers would help make the competitor's creator software more valuable too - something Adobe wouldn't be very happy about. In such a scenario, Adobe could use the method recited in claim 1 to make the installed base of Acrobat readers useless for viewing pdf software created by the competitor's unlicensed creator software. If in accordance with the invention, each Acrobat reader would read only pdf files containing a license stamp indicating that they were created by Adobe's licensed Acrobat creator software, Adobe's free viewer software would be unusable for viewing pdf files from other unlicensed sources. That is good from Adobe's point of view since it would make its competitor's pdf creator software less valuable.

The Examiner cites Downs (col. 30, line 35 through col. 31 line 30) as teaching claim 1. That portion of Downs defines various data that is included in Down's encrypted metadata secure container, but the Examiner does not indicate which of these data elements, if any, the Examiner considers similar to the "license stamp" recited in claim 1 which identifies the file as being created by licensed server software." The applicant has reviewed the cited section of Downs (and all other sections of Downs) to determine whether Downs suggest anything that might be relevant. The recited "license stamp" and only the following term (col. 30, lines 30-31) seemed relevant:

"SC Publisher--Indicates the entity that created the SC(s)."

Thus Downs teaches that the encrypted metadata secure container includes data identifying the publisher of the secure container. However nowhere in Downs do we find any suggestion that the SC Publisher data indicates that the creator entity was using licensed server software as recited by claim 1.

Although claim 1 recites "adapting the processing software (in the destination computer) ... so that it processes each data file ... only when [it] contains the embedded license stamp", nothing in Downs suggests that end-user software accessing the secured container content should do so only if the secured container includes a license stamp indicating that the secured container comes from licensed server

software. Nothing in Downs provides any indication as to what the end-user's software does, if anything, with the SC Publisher information included in the secure container. Downs teaches that end-user software should only be able to access the secured container if the end-user has acquired a valid license to do so and does not teach to prevent access to the secured container if the source of the secured container is not licensed server software as recited in claim 1. See Downs col. 6, line 66 through col. 7 line 10.

Thus Downs fails to teach or suggest either one of the two steps of the applicant's claim 1.

Claim 2

Claim 2 depends on claim 1 and is patentable over Downs for similar reasons. The Examiner's erroneous citation of Downs regarding claim 2 is irrelevant.

Claims 3

Claim 3 depends on claim 1 and is patentable over Downs for similar reasons. Claim 3 further recites that the file is a print file suitable for causing a printer to print a document. The Examiner's erroneous citation of Downs regarding claim 3 is irrelevant. Nothing anywhere in Downs mentions anything about a print file of the type which can be sent directly to a printer for causing a printer to print a document, or about embedding a license stamp in such a print file.

Claim 4

Claim 4 depends on claim 3 and is patentable over Downs for similar reasons. Claim 4 further recites that the license stamp is embedded in the print file in a way that the printer can ignore it when printing. The Examiner's erroneous citation of Downs regarding claim 4 is irrelevant. Nothing anywhere in Downs mentions anything about print files or embedding a license stamp in a print file.

Claim 5

Claim 5 depends on claim 3 and is patentable over Downs for similar reasons. Claim 5 further recites that the action carried out

by the destination computer (which is inhibited if the license code does not appear in the print file) comprises displaying an image of the document defined by the print file. The Examiner's erroneous citation of Downs regarding claim 5 is irrelevant. Nothing anywhere in Downs mentions anything about print files, about embedding a license code in a print file indicating that the file was generated by a licensed source, about software that can display an image of a document described by a print file, or about configuring such software to refrain from displaying such image when the print file does not contain the license code, all of which are limitations of claim 5.

Claim 6

Claim 6 depends on claim 3 and is patentable over Downs for similar reasons. Claim 6 further recites that the action carried out by the processing software (which is inhibited if the license code does not appear in the print file) is causing a printer to print the document described by the print file. The Examiner's erroneous citation of Downs regarding claim 6 is irrelevant. Nothing anywhere in Downs mentions anything about print files or printers.

Claims 7 and 8

Claims 7 and 8 depend on claim 1 and are patentable over Downs for similar reasons. Claim 7 further recites that the action carried out by said processing software (which is inhibited if the license code does not appear in the file) is initiating a sound. Claim 8 further recites that the action carried out by the processing software (which is inhibited if the license code does not appear in the file) is displaying a video image defined by the file. The Examiner's erroneous citations of Downs regarding claims 7 and 8 are irrelevant.

Nothing anywhere in Downs mentions anything about inserting a license code into an audio (or video) file indicating that the file was generated by a licensed source, or about configuring software that can initiate a sound (or display an image) in response to an audio (or video) file to refrain from initiating the sound (or generating the display) when the file does not contain such a license code, all of which are limitations of claim 7 or claim 8.

Claim 9

Claim 9 depends on claim 1 and is patentable over Downs for similar reasons. Claim 9 further recites that the license stamping means also process the data file to determine a value of an attribute of the data file and includes in the embedded license stamp an attribute code indicating that value. Claim 9 also recites that the processing software refrains from carrying out the action unless the value of the attribute of the data file matches the value indicated in the license stamp.

The Examiner's erroneous citation of Downs regarding claim 9 is irrelevant. Nothing anywhere in Downs mentions that license stamping means in a server should process a data file to determine a value of a data file attribute and include an attribute code indicating in that value in the embedded license stamp, and that the processing software receiving the file should be configured to refrain from carrying out an action with respect to that file unless the attribute value of the data file matches the value indicated in the license stamp.

Claim 10

Claim 10 depends on claim 9 and is patentable over Downs for similar reasons. Claim 10 further recites that the data file consists of a plurality of data bytes, each of which influences the value of the attribute. The Examiner's erroneous citation of Downs regarding claim 10 is irrelevant. Nothing anywhere in Downs mentions anything about the additional limitations of 10, namely that license stamping means in a server should process a data file to determine a value of a data file attribute and include an attribute code indicating in that value in the embedded license stamp, that the attribute code should be influenced by all bytes forming the file, that the processing software receiving the file should be configured to refrain from carrying out an action with respect to that file unless the attribute value of the data file matches the value indicated in the license stamp.

Claim 11

Claim 11 depends on claim 1 and is patentable over the Downs for similar reasons. The Examiner's erroneous citation of Downs regarding claim 10 is irrelevant.

Claims 12-22

Claims 12-22 are patentable over Downs for reasons similar to those expressed above in connection with claims 1-11, respectively.

Claims 23-25

Claims 23, 24, and 25 are patentable over Downs for reasons generally similar to those expressed above in connection with claims 1, 3, and 4, respectively.

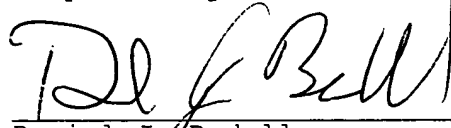
Claim 26

Claim 26 depends on claim 23 and is patentable over Downs for similar reasons.

The prior art made of record and not relied upon, but considered pertinent to the applicant's disclosure has been reviewed and does not appear to teach or suggest the applicant's invention as recited in the claims.

In view of the foregoing remarks, it is believed the application is in condition for allowance. Notice of Allowance is therefore respectfully requested.

Respectfully submitted,



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